

## REMARKS

The Examiner rejected claims 1-3, 5-7 and 11-13 under 35 U.S.C. § 102(b)<sup>1</sup> as being anticipated by Stein (U.S. Patent No. 5,628,055). Based on 35 U.S.C. § 103(a), the Examiner rejected claims 9-10 as being unpatentable over Stein, claims 4, 14-18 and 20-23 as being unpatentable over Stein in view of Kavanaugh, et al. (U.S. Patent No. 6,845,455), claim 8 as being unpatentable over Stein in view of Rydbeck, et al. (U.S. Patent No. 5,890,074), claim 19 as being unpatentable over Stein in view of Kavanaugh and further in view of Rydbeck, claim 24 as being unpatentable over Stein in view of Kavanaugh and further in view of Garcia (U.S. Publication No. 2003/0125054), claims 25-31 as being unpatentable over Stein in view of Rydbeck and further in view of Kavanaugh and claim 32 as being unpatentable over Stein in view of Rydbeck in view of Kavanaugh and Garcia. In response, the Applicant has amended certain claims and has set forth arguments supporting the patentability of the amended claims over the prior art references. The Applicant believes the amendments made in response to the Examiner's rejections have placed the application in position for allowance.

## Amendments to the Claims

Applicant has amended claims 1, 4, 8-10, 14-15, 19-21, 24-25, 27-30 and 32 to address the Examiner's rejection under 35 U.S.C. §§ 102(b) and 103(a). Specifically, Applicant is amending these claims as set forth below:

a) claim 1 - Amending this claim to add the limitation that the wafer mobile phone platform system of the present invention includes a memory storage device on the mobile phone wafer that is connected to the transceiver unit and configured to store data that is accessible by the transceiver unit. Also amending this claim to replace “a source of electrical power” with a battery and to clarify that the wafer mobile phone wafer can be utilized, selectively, as both a stand alone mobile phone for wireless

<sup>1</sup> The Office Action by the Examiner identified this rejection as being based on 35 U.S.C. § 103(a), but is believed to have been intended by the Examiner to be a rejection under § 102(b) instead. The Examiner confirmed this in a message left with the Applicant's attorney on October 10, 2006.

1 voice communication (i.e., without the use of any peripheral device) and be connected to a peripheral  
2 device so that it can be used to transmit voice and data over the wireless communication network. This  
3 amendment is supported by the text and drawings of the disclosure. Specifically, the memory storage  
4 device is set forth in the specification at least at the following locations: page 16, line 18 (and identified  
5 as numeral 21 in the figures); page 17, lines 6-9; and page 30, lines 7-11. Use of the memory storage  
6 device to access or transfer data between the wafer and the peripheral device is set forth at least at the  
7 following locations: page 20, lines 7-9; page 22, line 18 through page 23, line 1; page 23, lines 11-14,  
8 page 24, line 17 through page 25, line 3 and page 25, line 18 through page 26, line 2. The use of a  
9 battery, such as a rechargeable battery is supported by the description at least at page 10, lines 10-12 and  
10 page 17, lines 4-6 (and identified as numeral 20). Use of the wafer as a stand alone mobile phone is set  
11 forth in the text at least at the following locations: pages 8, lines 17-19; page 12, lines 8-10; page 29, line  
12 17 through page 30, line 13.

13           b) claim 4 - Amending this claim to require the mobile phone wafer to comprise an on/off switch  
14 and a display screen operatively connected to the transceiver unit. This amendment is supported by the  
15 description and original claims.

16           c) claim 8 - Amending this claim to clarify that the communication device comprises a short  
17 range radio frequency transceiver, as it may also comprise a headphone jack (claim 10). Support for this  
18 amendment is set forth in the description at least at page 18, lines 2-5.

19           d) claim 9 - Amending this claim to clarify that the short range radio frequency transceiver can  
20 comprise at least one (or both) of a Bluetooth module and a Wi-Fi module. This amendment is  
21 supported by the description and original claims.

22           e) claim 10 - Amending this claim to require the communication device to further comprise a  
23 headphone jack in addition to the short range radio frequency transceiver. This amendment is supported  
24 by the description and original claims.

25           f) claim 14 - Amending this independent claim in the same manner as claim 1 set forth above.

26           g) claim 15 - Amending this claim in the same manner as claim 4 above.

27           RESPONSE/AMENDMENT

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1           h) claims 19-21 - Amending these claims in the same manner as claims 8-10 above.

2           i) claim 24 - Amending this claim to require the use of an on/off switch connected to the  
3 transceiver unit and the communication device configured for a wired connection to the peripheral  
4 device and comprising at least one of a short range radio frequency transceiver and a headphone jack.  
5 This amendment is supported by the description and original claims.

6           j) claim 25 - Amending this independent claim in the same manner as claims 1 and 14 above and  
7 to require the communication device to comprise a short range radio frequency transceiver. As set forth  
8 above, this amendment is supported by the description and original claims.

9           k) claim 27 - Amending this claim to require the communication device to further comprise a  
10 headphone jack.

11           l) claims 28-29 - Amending this claim in the same manner as claims 9 and 10 above.

12           m) claim 30 - Amending this claim to depend from claim 29 instead of 25 and clarifying that the  
13 communication device is configured for wired connection.

14           n) claim 32 - Amending this claim to require the communication device to also be configured for  
15 a wired connection. This is the same claim as original claim 30 (with the “configured” amendment), just  
16 depending on claim 25 instead of 29.

17

18 Rejection under 35 U.S.C. § 102(b)

19           With regard to the rejection of claims 1-3, 5-7 and 11-13 under 35 U.S.C. § 102(b) as  
20 being anticipated by Stein, the Applicant respectfully disagrees with the Examiner (as the claims have  
21 been amended herein). Stein does not disclose each and every element of Applicant’s claimed invention  
22 as required for a Section 102(b) rejection. (Lindemann Maschinenfabrik GMBH v. American Hoist &  
23 Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984); W.L. Gore & Associates, Inc. v. Garlock, Inc., 220  
24 USPQ 303, 313 (Fed. Cir. 1983).) In particular, Stein does not disclose the use of memory storage  
25 device on the mobile phone wafer (or module as described in Stein) or a battery on the wafer/module and  
26 does not disclose the use of the wafer as a stand alone unit for mobile phone for wireless voice

1 communication. As set forth throughout Applicant's specification, Applicant's invention is to provide a  
2 new and useful communication device that enables the user to utilize the wafer alone as a minimalist  
3 mobile phone to transmit voice communications over a wireless network or to connect the wafer to a  
4 peripheral device to enable the user to utilize the peripheral device for wireless voice and data  
5 communication. Stein does not disclose the use of the module as a stand alone device

6           Although Stein discloses a telecommunications module that enables a peripheral device  
7 to link to a wireless network for transmission of voice or data over the wireless network, for purpose of  
8 enabling connection to different formats and standards, Stein does not disclose, compel, teach or even  
9 suggest utilizing the module as a stand alone device. As such, there is no reason for Stein to include a  
10 memory storage device to store data or a battery to provide its own electrical power. As discussed in the  
11 patent, the module is configured to provide modular telecommunications capability to a peripheral  
12 device that contains the data and power necessary to perform the desired functions. In effect, the module  
13 of Stein is essentially a PCMCIA card-like module that is suitable for connection to a computer, PDA or  
14 cellular phone to provide the modem connection to the wireless network that enables the user to transmit  
15 voice or data. Any data utilized by the module to connect to or transmit across the wireless network is  
16 obtained from, and only from, the peripheral device. Because the module of Stein is not utilized by  
17 itself, it is not necessary to provide it with a battery power. Stein discloses the use of a AC/DC power  
18 device or being able to utilize the power of the peripheral device. Functional portability of the module  
19 was not an issue in Stein.

20           In contrast to Stein, the claims of the present patent application (as amended) include a  
21 memory storage device that is connected to the transceiver unit and configured to store data, such as  
22 names and phone numbers, that is accessible by the transceiver unit. For portability, power is supplied  
23 by a battery on the mobile phone wafer. In a preferred embodiment, the battery is rechargeable from a  
24 variety of sources, including the peripheral device. As clarified in the amendments, the wafer mobile  
25 phone platform system of Applicant's invention is suitable for being used as a stand alone mobile phone  
26 for wireless voice communication. In this use, the wafer phone would be a minimalist phone that can be

1 easily carried in a pocket or elsewhere on or in the user's clothing. In addition, the wafer phone can  
2 then, selectively, be connected to a peripheral device to enable the peripheral device to communicate  
3 over the wireless network to transmit voice and/or data communications.

4 As set forth in the specification of the present application, the objective of Applicant's  
5 invention is to enable a person to purchase a single mobile phone wafer that he or she can utilize on its  
6 own or with a variety of different peripheral devices. Because the wafer connects to peripheral devices,  
7 it will not be necessary to provide the peripheral device with the telecommunications capability that is  
8 provided on the wafer (which enables the stand alone use). This can save the user a significant amount  
9 of money and reduce the problems users typically have with regard to different communication devices.  
10 For instance, instead of purchasing a cell phone, laptop and PDA that each have their own separate  
11 telecommunications capability, each of the peripheral devices can be provided without this capability  
12 and the user can connect the wafer to a particular peripheral device on an as-needed basis. As such, it is  
13 anticipated that the cost of the various peripheral devices will be much lower than they are currently. In  
14 addition to the lower initial cost, the user will save money as the manufacturers come out with peripheral  
15 devices having new and improved features. For instance, when a new cell phone is available that has  
16 features desired by the user, he or she would only have to purchase the "shell" cell phone with those new  
17 features. The wafer can be utilized with the new phone and the old phone shell can be discarded.  
18 Presently, when a person purchases a new cell phone (also true with laptops, PDAs and other devices),  
19 the telecommunications electronics that enable connection to a wireless network still function in the  
20 same manner but, despite this, they are discarded with the old phone. The Applicant anticipates that this  
21 will significantly reduce buyer concern and anxiety with regard to spending significant sums of money to  
22 purchase the newest and latest improvement in technology only to see the expensive device become  
23 substantially obsolete in a few months. With the wafer of Applicant's invention, the user keeps the  
24 expensive telecommunications component (the wafer) and only has to buy the upgraded shell (i.e., the  
25 cell phone having the latest camera and/or video capabilities).

26

27

RESPONSE/AMENDMENT

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1           In order to serve as a reference under 35 U.S.C. § 102(b), the reference must be enabling  
2 as to the features to which anticipation is suggested. (Akzo N.V. v. U.S. Int'l Trade Comm., 1 USPQ2d  
3 1241, 1245 (Fed. Cir. 1986); In re Donohue, 226 USPQ 619, 621-22 (Fed. Cir. 1985); W.L. Gore &  
4 Associates, Inc., 220 USPQ at 314.) Anticipation cannot be predicated on mere conjecture regarding the  
5 characteristics of various features of the invention disclosed in the reference. (See W.L. Gore &  
6 Associates, Inc., 220 USPQ at 314.) As set forth above, with regard to Applicant's amended claims,  
7 Stein does not disclose the use or need for a memory storage device or a battery and does not disclose or  
8 suggest use of the module as a stand alone device. Therefore, it is Applicant's position that amended  
9 independent claim 1 is not, respectfully, anticipated by the patent Stein. Because claim 1 is believed to  
10 be allowable, it is also believed that the dependent claims are also allowable.

11  
12 Rejection under 35 U.S.C. § 103(a)  
13           With regard to the obviousness rejections for claims 4, 8-10 and 14-32, which are based  
14 on Stein and other identified prior art, Section 103(a) only denies patentability to those inventions whose  
15 "subject matter as a whole would have been obvious at the time the invention was made to a person  
16 having ordinary skill in the art to which said subject matter pertains." (35 U.S.C. § 103.) Initially,  
17 Applicant believes the amendments to the independent claims with regard to the inclusion of a memory  
18 storage device and battery make these claims allowable, thereby making the dependent claims also  
19 allowable. In addition, as stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987),  
20 "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed  
21 invention, absent some teaching, suggestion or incentive supporting the combination." (In re Geiger, 2  
22 USPQ2d at 1278.) The motivation or suggestion to combine references must exist, otherwise the  
23 determination of obviousness involves nothing more "than indiscriminately combining prior art." (Micro  
24 Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC 1997).) In In re Fritch, 23  
25 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:  
26  
27

1 In proceedings before the Patent and Trademark Office, the Examiner bears the burden of  
2 establishing a *prima facie* case of obviousness based upon the prior art. The Examiner can satisfy  
3 this burden only by showing some objective teaching in the prior art or that knowledge generally  
available to one of ordinary skill in the art would lead that individual to combine the relevant  
teachings of the references.

4 Obviousness cannot be established by combining the teachings of the prior art to produce the  
5 claimed invention, absent some teaching or suggestion supporting the combination. Under  
6 section 103, teachings of references can be combined *only* if there is some suggestion or  
incentive to do so. Although couched in terms of combining teachings found in the prior art, the  
7 same inquiry must be carried out in the context of a purported obvious "modification" of the  
prior art. The mere fact that the prior art may be modified in the manner suggested by the  
8 Examiner does not make the modification obvious unless the prior art suggested the desirability  
of the modification.

9 Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is  
10 impermissible to use the claimed invention as an instruction manual or "template" to piece  
11 together the teachings of the prior art so that the claimed invention is rendered obvious. This  
court has previously stated that one cannot use hindsight reconstruction to pick and choose  
among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch, 23  
12 USPQ2d at 1783-84 (internal quotes and citations removed).)

13 Claims 9 & 10

14 The Examiner rejected claims 9 and 10 under Section 103(a) as being unpatentable over  
15 Stein and knowledge commonly known in the art. Original claims 9 and 10 were further defined the  
16 short range radio frequency transceiver (communication device) of claim 8 as a Bluetooth module or a  
17 WiFi module, respectively. Currently claim 9 combines these two claims and claim 10 adds the  
18 limitation that the communication device includes a headphone jack in addition to the short range radio  
19 frequency transceiver. With the amendments to claim 1 set forth above, it is believed that these claims  
20 are also allowable.

21  
22 Claims 4, 14-18 & 20-23

23 The Examiner rejected claims 4, 14-18 and 20-23 under Section 103(a) as being  
24 unpatentable over Stein and Kavanaugh. The Examiner appears to take the position that the use of a  
25 display screen, on/off switch and headphone jack on Applicant's wafer mobile phone platform system  
26 is not disclosed by Stein but is made obvious by Kavanaugh. Applicant respectfully disagrees with the

1 Examiner. Kavanaugh discloses a personal information device or PID in the form of an electronic  
2 organizer. As set forth at column 4, lines 21-46 and column 5, lines 35-49, the PID is in the form of a  
3 PCMCIA card that has a flat panel display 12 and various buttons 14 thereon that is either inserted into  
4 the PCMCIA slot of a personal computer or connected to the computer with a serial cable for purposes  
5 of transferring data to the PID. Nothing in Kavanaugh or Stein suggests combining the screen of  
6 Kavanaugh with the communications card of Stein, particularly as the claims of Applicant's invention  
7 are amended herein to further distinguish Applicant's invention from the module of Stein. As discussed  
8 above, Stein is merely a universal communication card that enables a peripheral device to connect to a  
9 wireless network and nothing in Stein discloses, compels or suggests utilizing the module as a stand  
10 alone mobile phone. As such, there is simply no reason why a person skilled in the art would find it  
11 necessary or desirable to add the screen of Kavanaugh (or any other screen containing device) to the  
12 communication card of Stein. Because Stein's module does not function on its own, it is unnecessary for  
13 the user to have a screen display. With regard to displaying the status information of the peripheral  
14 device, the peripheral devices have their own screens (i.e., the cell phone, laptop or PDA described in  
15 Stein) and, as such, it would be somewhat redundant to provide a display screen on Stein's module to  
16 see the status of the peripheral device. Likewise, because the module of Stein does not have any  
17 memory capability (nor is any needed), it would not be necessary for a person skilled in the art to add the  
18 display screen "in order to display identification data or view the displayed status information of the  
19 card" as described by the Examiner (Office Action page 7, lines 12-15). As a result, it would not have  
20 been obvious to a person skilled in the art to combine Kavanaugh with Stein to arrive at the subject  
21 claims. The same analysis applies to incorporating an on/off switch or a headphone jack on Applicant's  
22 wafer. There is no motivation or suggestion in the referenced prior art to combine the attributes of  
23 Kavanaugh identified by the Examiner with the module of Stein to arrive at Applicant's claims,  
24 particularly as amended. Respectfully, adding the screen of Kavanaugh to Stein to arrive at a mobile  
25 phone wafer that is capable of both stand alone use and connection to a peripheral device may be a case  
26 of impermissible hindsight.

1      Claim 8

2                The Examiner rejected claim 8 under Section 103(a) as being unpatentable over Stein in  
3 view of Rydbeck (which patent is “related” to Stein - one of the co-inventors) . The Examiner states that  
4 Stein does not disclose the communication device is a short range radio frequency transceiver but that  
5 Rydbeck discloses a communication device within a wafer card and a short range radio frequency  
6 transceiver and it would have been obvious to combine this with Stein to arrive at Applicant’s invention.  
7 As set forth above with regard to Stein, Applicant respectfully disagrees with this conclusion,  
8 particularly as to the amended claim 1, from which claim 8 depends. Because claim 1 is believed to be  
9 allowable, it is also believed claim 8 is allowable.

10

11      Claim 19

12                The Examiner rejected claim 19 under Section 103(a) as being unpatentable over Stein in  
13 view of Kavanaugh and further in view of Rydbeck, under the same rationale use to reject claim 8 above.  
14 In light of the amendments to claim 14 included herein, from which claim 19 depends, claim 19 is  
15 believed to be allowable. In addition, the arguments with regard to the obviousness of claims 1 and 14  
16 with regard to Stein, which are incorporated herein, are also applicable to claim 19.

17

18      Claim 24

19                The Examiner rejected claim 24 under Section 103(a) as being unpatentable over Stein in  
20 view of Kavanaugh and further in view of Garcia. The Examiner acknowledges that neither Stein nor  
21 Kavanaugh disclose the source of electrical power being a rechargeable battery. According to the  
22 Examiner, Garcia discloses the source of electrical power being a rechargeable battery and that it would  
23 have been obvious to combine that with Stein and Kavanaugh to obtain Applicant’s invention.  
24 Respectfully, as set forth above with regard to the obviousness of claims 1 and 14, from which claim 24  
25 depends, the Applicant disagrees with the Examiner. In addition, because claim 14 is believed to be  
26 allowable, claim 24 is also believed to be allowable.

27

RESPONSE/AMENDMENT

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1      Claims 25-31

2                The Examiner rejected claims 25-31 under Section 103(a) as being unpatentable over  
3 Stein in view of Rydbeck in further view of Kavanaugh. The rationale for this rejection appears to be  
4 the same as set forth in the rejections of claims 1 under Stein, claims 4, 14-18 and 20-23 under Stein and  
5 Kavanaugh and the disclosure in Rydbeck of an individual reception device. Applicant incorporates  
6 those arguments herein. As set forth in the above arguments, Applicant respectfully disagrees with the  
7 Examiner with regard to the obviousness rejections under Stein and Kavanaugh (separately or combined).  
8 Even if Rydbeck discloses the use of an individual reception device, nothing in any of these references  
9 discloses, suggests, teaches or compels the use of such a device with a wafer that is configured for stand  
10 alone communications and connection to one or more peripheral devices, as set forth in the Applicant's  
11 amended claims.

12

13      Claim 32

14                The Examiner rejected claim 32 under Section 103(a) as being unpatentable over Stein in  
15 view of Rydbeck in view of Kavanaugh and in view of Garcia. The rationale for this rejection appears to  
16 be the same as set forth above with regard to previously reviewed claim 1 under Stein, claims 4, 14-18  
17 and 20-23 under Stein and Kavanaugh, claim 8 under Stein and Rydbeck and claim 24 under Stein,  
18 Kavanaugh and Garcia. The Applicant incorporates those arguments herein. In addition, because claim  
19 32 depends from amended independent claim 25, which is believed allowable, it is also believed to be  
20 allowable.

21                In light of the above amendments and arguments, Applicant respectfully requests the  
22 Examiner to withdraw the rejection of the claims, as amended, in the subject patent application.

23                Applicant's original application included fees for three independent claims and a total of  
24 thirty-two claims. No claims are being added and none are being deleted, therefore, after this  
25 amendment a total of thirty-two claims, including three independent claims, are pending in this  
26 application. No additional fees for claims are believed due.

27      RESPONSE/AMENDMENT

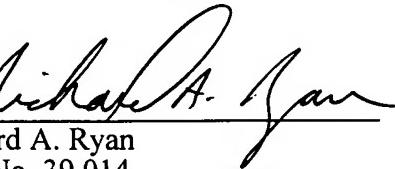
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1           In view of the foregoing, it is submitted that this application is in condition for allowance.  
2 Reconsideration of the rejections in light of this Amendment is requested. Applicant believes that the  
3 amended claims are in condition for allowance. Allowance of claims 1-32 is respectfully solicited.

4

5           Dated: October 12, 2006

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